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Paper No. 8

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DEC 10 2004

OFFICE OF PETITIONS

In re Application of :
James J. Nicholas :
Application No. 10/029,887 :
Filed: December 20, 2001 :
Title: NON-INTRUSIVE INTERACTIVE :
NOTIFICATION SYSTEM AND METHOD :

DECISION ON PETITION UNDER
37 C.F.R. §1.78(A)(3)

This is a decision on the petition pursuant to 37 C.F.R. §1.78(a)(3), filed December 5, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of a prior-filed non-provisional application.

On December 20, 2001, the above-identified application was filed with a declaration which identified the filing date of prior filed application numbers 09/314,128 and 09/632,474 as May 19, 1999 and August 4, 2000, respectively. The specification of the above-identified application set forth that it is a continuation-in-part (CIP) of the '474 application, but failed to indicate that the '474 application is a CIP of the '128 application.

35 U.S.C. 120 Benefit of earlier filing date in the United States:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 9, 89 Stat. 691; Nov. 8, 1984, Public Law 98-622, sec. 104(b), 98 Stat. 3385; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec. 4503(b)(1))).

§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications:

(a)(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. §§120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 35 U.S.C. §§120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

- (i) The reference required by 35 U.S.C. §120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;
- (ii) The surcharge set forth in §1.17(t); and
- (iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

37 C.F.R. §1.78(a)(3) requires a statement that the entire delay between the date the claim was due under 37 C.F.R. §1.78(a)(2)(ii) and the date the claim was filed was unintentional. Since the statement contained in the instant petition varies from the language required by 37 C.F.R. §1.78(a)(3), the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. §1.78(a)(3) and petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition.

With the instant petition, Petitioner has included the appropriate reference to the prior-filed application, the required fee, and has made a statement which is being construed as the proper statement of unintentional delay.

As such, the petition under 37 CFR 1.78(a)(3) is **GRANTED**.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the Examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

The petition under 37 C.F.R. §1.53:

Petitioner has also filed a request for a corrected filing receipt. A corrected filing receipt has been enclosed with this decision.

After this petition is mailed, the application will be forwarded Technology Center 2100 for further processing.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

Frances Hicks
Frances Hicks
Petitions Examiner
Office of Petitions
United States Patent and Trademark Office

Encl. Corrected filing receipt